

## **REMARKS**

Support for the amendment to the claims may be found in Applicants' specification as originally filed at pages 21-29. No new matter has therefore been introduced.

In the 08/08/2005 Office Action, the Examiner has acknowledged Applicants' withdrawal of claims **14-21** and **35-47**. Claims **1-13** and **22-34** stand rejected. After entry of the preceding amendments, claims **1-13** and **22-34** remain pending in the instant application. Reconsideration of previously pending claims **1-13** and **22-34** and allowance of all claims **1-13** and **22-34** is respectfully requested.

As a preliminary matter, the undersigned thanks the Examiner for the courtesy of the informal telephone conference conducted on 09/21/2005. As stated during the conference, Applicants believe all amended claims to be allowable over the art of record.

### **35 USC § 102(b)**

Claims **1-13** and **22-34** stand rejected under 35 U.S.C. § 102(b) as being anticipated, or alternatively under 35 U.S.C. § 103(a) as being obvious, in view of Koulbanis *et al.* US 4,324,802. The Examiner has utilized the conjunction "or" in the construction of the basis/bases for rejection. Accordingly, the rejection is not clear and does not particularly point out the basis/bases for rejection. Applicants are unable to determine if the Examiner proposes that Koulbanis is intended to be applied in view of the novelty requirements of 35 U.S.C. § 102(b), the non-obviousness requirements of 35 U.S.C. § 103(a), or both. One possible interpretation of the rejection (at least as it currently reads) is that the Examiner considers the rejection under 35 U.S.C. § 102(b) to be of such insubstantial weight as to warrant the fall-back position that the reference probably meets the criteria for establishing a *prima facie* case for obviousness under 35 U.S.C. § 103(a). Applicants respectfully request clarification on this point so that the record of prosecution is rendered clear on potential Appeal.

With respect to claims **1-13** and **22-34**, the Examiner suggests that Example 3 of Koulbanis discloses "unsaponifiable of the instant Jojoba oil (example A) inherently at least 6% prior to hydrolysis, of example A (col. 4) are mixed with polar hydrophilic salts from saponifiable fraction-glycerol stearate". Applicants are affirmatively unable to decipher or otherwise interpret

this sentence. Applicants assume that the reference to “unsaponifiabler” is a spelling error, and should read ‘unsaponifiablers’. Applicants likewise assume that the reference to “unsapouifiablers” is a spelling error, and should read ‘unsaponifiablers’ as well. Clarification on these points is respectfully requested so that Applicants are given a full and fair opportunity to respond to the Examiner's rejection, so that the record of prosecution may be rendered clear on potential Appeal.

The Examiner goes on to propose that “[n]o patentable weight is given to how the salts or unsapouifiablers are arrived at in the claim to the composition intended for topical use” (presumably claim 1). Again, Applicants assume that the reference to “unsapouifiablers” is a spelling error, and should read ‘unsaponifiablers’. Clarification on this point is respectfully requested in order to afford the Applicants a full and fair opportunity to respond to the Examiner's rejection, so that the record of prosecution may be rendered clear on potential Appeal.

The Examiner then goes on to assert that “Koulbanis shows topical use, and the unspecified in instant claim”. Applicants are affirmatively unable to decipher or otherwise interpret this sentence. Clarification on this point is respectfully requested so that Applicants may be given a full and fair opportunity to respond to the Examiner's rejection, thereby rendering the record of prosecution clear for potential Appeal.

The Examiner then states “Polar salts with nonpolar unsapouifiablers, of those of the instant organic materials, including Jojoba oil”. Applicants are affirmatively unable to decipher or otherwise interpret this sentence. In addition to the spelling error (“unsapouifiablers”), the sentence has no discernable verb. The Applicants trust that the Examiner will not view the identification of spelling errors as excessively critical; rather, since distinctions are made between saponifiable and unsaponifiable materials, it is important to understand which classification the Examiner intends to reference. That notwithstanding, this sentence is completely devoid of meaning. Clarification on these points is respectfully requested so that Applicants may be given a full and fair opportunity to respond to the Examiner's rejection, thereby rendering the record of prosecution clear for potential Appeal.

It is important for the Examiner to acknowledge and note that Applicants' have detrimentally limited the subject matter of their claims as drawn to only the polar hydrophilic salts which result from the hydrolysis of an organic starting material comprising at least more than 10 weight

percent of unsaponifiable material and/or long carbon chain organics prior to hydrolysis. For the Examiner to suggest that these substantial limitations should not be given "patentable weight" is absurd. Applicants would not have included these limitations unless they were deemed relevant to define and enable the instant invention. Accordingly, it is important for the Examiner to acknowledge that Koulbanis nowhere discloses or claims a hydrolysis process for producing polar hydrophilic salts (*e.g.*, product by process).

*N.B.* - If the Examiner considers that it might help to advance prosecution in this case, Applicants would appreciate the opportunity to discuss the possibility of recasting the pending claims in product-by-process language.

Since all of Applicants' claims are drawn to the use of polar hydrophilic salts resulting from the hydrolysis of an organic starting material comprising at least more than 10 weight percent of unsaponifiable material and/or long carbon chain organic material prior to hydrolysis, the Koulbanis reference may not properly be used to formulate a rejection under U.S.C. § 102(b) – inasmuch as Koulbanis fails to disclose *inter alia* "polar hydrophilic salts; and non-polar unsaponifiables; wherein [the] polar hydrophilic salts [are derived from] hydrolysis of a saponifiable fraction of original organic material that comprises" more than "10 weight percent unsaponifiable material" and/or more than "10 weight percent long carbon chain material prior to hydrolysis". See Applicants claims **1** and **22**, as amended.

Claims **1** and **22**, therefore, may not be properly regarded as anticipated by the Koulbanis reference under § 102(b). To the extent that claims **2-13** and **23-34**, respectively depend from and incorporate all of the limitations of claims **1** and **22**, claims **2-13** and **23-34** are similarly allowable over Koulbanis. Applicants therefore submit that claims **1-13** and **22-34**, as amended, are allowable over Koulbanis and respectfully request that the Examiner withdraw the § 102(b) rejections of the same.

Claims **1-13** and **22-34** stand rejected under 35 U.S.C. § 102(b) as being anticipated, or alternatively under 35 U.S.C. § 103(a) as being obvious, in view of Moy US 5,928,659. The Examiner has utilized the conjunction "or" in the construction of the basis/bases for rejection. Accordingly, the rejection is not clear and does not particularly point out the basis/bases for rejection. Applicants are unable to determine if the Examiner proposes that Moy is intended to be applied in view of the novelty requirements of 35 U.S.C. § 102(b), the non-obviousness requirements of 35 U.S.C. § 103(a), or both. One possible interpretation of the rejection (at

least as it currently reads) is that the Examiner considers the rejection under 35 U.S.C. § 102(b) to be of such insubstantial weight as to warrant the fall-back position that it probably meets the criteria for establishing a *prima facie* case for obviousness under 35 U.S.C. § 103(a).

Applicants respectfully request clarification on this point so that the record of prosecution is rendered clear on potential Appeal.

With respect to claims 1-13 and 22-34, the Examiner suggests that the Moy reference discloses unsaponifiables with polar hydrophilic salts – at least, this is what Applicants' assume the Examiner intends to communicate. The actual sentences for the Examiner's Office Action read:

“10% unsaponifiables (UFA) with polar hydrophilic salts, lanolin soaps (col.6, lines 27-44) or example 4; 8% UFA with glycerolstearate are disclosed. These are the instant compositions, based, again, on the instant organic avocado seed oil, thus inherently of the instant properties. The benefits here amelioration of keratoses, while added metal chelates provide healing (col. 8, lines 6-16).”

The second and third sentences are sufficiently poorly worded to render their meaning indistinct. Clarification on this point is respectfully requested so that the record of prosecution may be rendered clear on potential Appeal. That notwithstanding, nowhere does Moy disclose or claim a hydrolysis process for producing polar hydrophilic salts.

*N.B.* - If the Examiner considers that it might help to advance prosecution in this case, Applicants would appreciate the opportunity to discuss the possibility of recasting the pending claims in product-by-process language.

Since all of Applicants' claims are drawn to the use of polar hydrophilic salts resulting from the hydrolysis of an organic starting material comprising at least more than 10 weight percent of unsaponifiable material and/or long carbon chain organic material prior to hydrolysis, the Moy reference may not properly be used to formulate a rejection under U.S.C. § 102(b) – inasmuch as Moy fails to at least disclose “polar hydrophilic salts; and non-polar unsaponifiables; wherein [the] polar hydrophilic salts [are derived from] hydrolysis of a saponifiable fraction of original organic material that comprises” more than “10 weight percent unsaponifiable material” and/or

more than "10 weight percent long carbon chain material prior to hydrolysis". See Applicants claims **1** and **22**, as amended.

Claims **1** and **22**, therefore, may not properly be regarded as anticipated by the Moy reference under § 102(b). To the extent that claims **2-13** and **23-34**, respectively depend from and incorporate all of the limitations of claims **1** and **22**, claims **2-13** and **23-34** are similarly allowable over the cited reference. Applicants therefore submit that claims **1-13** and **22-34**, as amended, are allowable over Moy and respectfully request that the Examiner withdraw the § 102(b) rejections of the same.

Claims **1-3**, **6**, **7**, **10-13**, **22-24**, **27**, **28** and **31-34** stand rejected under 35 U.S.C. § 102(b) as being anticipated by Dreger US 2,240,365. The Examiner suggests that the Dreger reference discloses tall oil (purportedly containing 8 or 10% "unsaponifiables") mixed with polar hydrophilic salts of sodium soaps. Notwithstanding the fact that nowhere does Dreger disclose or claim a hydrolysis process for producing polar hydrophilic salts, Applicants' instant amendments have rendered the Examiner's rejection in view of Dreger moot.

Since all of Applicants' claims are drawn to the use of polar hydrophilic salts resulting from the hydrolysis of an organic starting material comprising at least more than 10 weight percent of unsaponifiable material and/or long carbon chain organic material prior to hydrolysis, the Dreger reference may not properly be used to formulate a rejection under U.S.C. § 102(b) – inasmuch as Dreger fails to at least disclose "polar hydrophilic salts; and non-polar unsaponifiables; wherein [the] polar hydrophilic salts [are derived from] hydrolysis of a saponifiable fraction of original organic material that comprises" more than "10 weight percent unsaponifiable material" and/or more than "10 weight percent long carbon chain material prior to hydrolysis". See Applicants' claims **1** and **22**, as amended.

Claims **1** and **22**, therefore, may not properly be regarded as anticipated by the Dreger reference under § 102(b). To the extent that claims **2-3**, **6**, **7**, **10-13**, **23-24**, **27**, **28** and **31-34** variously depend from and incorporate all of the limitations of claims **1** and **22**, claims **2-3**, **6**, **7**, **10-13**, **23-24**, **27**, **28** and **31-34** are similarly allowable over the cited reference. Applicants therefore submit that claims **1-3**, **6**, **7**, **10-13**, **22-24**, **27**, **28** and **31-34**, as amended, are allowable over Dreger and respectfully request that the Examiner withdraw the § 102(b) rejections of the same.

### 35 USC § 103(a)

Claims **1-13** and **22-34** stand rejected under 35 U.S.C. § 103(a) as being obvious, or alternatively under 35 U.S.C. § 102(b) as being anticipated, by Koulbanis *et al.* US 4,324,802. The Examiner has utilized the conjunction “or” in the construction of the basis/bases for rejection. Accordingly, the rejection is not clear and does not particularly point out the basis/bases for rejection. Applicants are unable to determine if the Examiner proposes that Koulbanis is intended to be applied in view of the non-obviousness requirements of 35 U.S.C. § 103(a), the novelty requirements of 35 U.S.C. § 102(b), or both. One possible interpretation of the rejection (at least as it currently reads) is that the Examiner considers the rejection under 35 U.S.C. § 103(a) to be of such insubstantial credible weight as to warrant expanding the volume of the rejection by including a novelty rejection under 35 U.S.C. § 102(b) as well. Applicants respectfully request clarification on this point so that the record of prosecution may be rendered clear on potential Appeal.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP 2143. Additionally, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims **1-13** and **22-34** stand rejected under 35 U.S.C. § 103(a) as being purportedly obvious in view of Koulbanis. Applicants respectfully traverse this rejection.

Applicants submit that Koulbanis does not teach or suggest “polar hydrophilic salts; and non-polar unsaponifiables; wherein [the] polar hydrophilic salts [are derived from] hydrolysis of a saponifiable fraction of original organic material that comprises” more than “10 weight percent unsaponifiable material” and/or more than “10 weight percent long carbon chain material prior to hydrolysis” as set forth in Applicants' claims **1** and **22**, as amended, from which claims **2-13** and **23-34** respectively depend. Applicants further submit that there is no motivation or suggestion to be found in the Koulbanis reference, nor in the knowledge generally available to one of

ordinary skill in the art, to modify Koulbanis or to combine Koulbanis with any other reference to practice the invention of Applicants' claims **1** and **22**.

It is important to note that the Examiner has failed to disclose a combination of Koulbanis with any reference or teaching of record. Accordingly, there can be no motivation or suggestion to combine when a combination is not even proposed. Applicant's respectfully request clarification on this point so that Applicants are not forced to perform guesswork to determine how the Examiner has formulated the rejection under 35 U.S.C. § 103(a).

Additionally, because there is no motivation or suggestion to combine Koulbanis with any other reference to practice the invention of claims **1** and **22**, there can be no reasonable expectation of success. Accordingly, claims **1** and **22** may not properly be regarded as obvious under § 103(a). See, for example, *Akamai Technologies, Inc. v. Cable & Wireless Internet Services, Inc.*, 344 F.3d 1186 (Fed. Cir. 2003) (There must be some teaching, suggestion, or motivation to combine references.); *Teleflex, Inc. v. Ficosa North American Corp.*, 299 F.3d 1313 (Fed. Cir. 2002) (The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence.) (citing *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999)); *Carella v. Starlight Archery*, 804 F.2d 135 (Fed. Cir. 1986) (Obviousness cannot be established by combining teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting a combination.); *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984) (The fact that the prior art could be modified so as to produce the claimed invention is not a basis for an obviousness rejection, unless the prior art suggested the desirability of the modification.); and *Ex parte Walker*, 135 USPQ 195 (POBA 1961) (A combination of teachings must be proposed and the art should contain some suggestion of the desirability of making the proposed combination.)

"With respect to core factual findings in a determination of patentability, [the Examiner] cannot simply reach conclusions based on [his/her] own understanding or experience – or on [his/her] assessment of what would be basic knowledge or common sense. Rather [the Examiner] must point to some concrete evidence in the record in support of these findings." *In Re Zurko*, 258 F.3d 1379 (2001).

Inasmuch as claims **2-13** and **23-34** respectively depend from, further limit and incorporate all of the elements of claims **1** and **22**, these claims are also allowable over the cited art. Applicants

therefore submit that claims **1-33** and **22-34** are allowable in view of Koulbanis and respectfully request Examiner to withdraw the § 103(a) rejections of the same.

Claims **1-13** and **22-34** stand rejected under 35 U.S.C. § 103(a) as being obvious, or alternatively under 35 U.S.C. § 102(b) as being anticipated, by Moy *et al.* US 5,928,659. The Examiner has utilized the conjunction “or” in the construction of the basis/bases for rejection. Accordingly, the rejection is not clear and does not particularly point out the basis/bases for rejection. Applicants are unable to determine if the Examiner proposes that Moy is intended to be applied in view of the non-obviousness requirements of 35 U.S.C. § 103(a), the novelty requirements of 35 U.S.C. § 102(b), or both. One possible interpretation of the rejection (at least as it currently reads) is that the Examiner considers the rejection under 35 U.S.C. § 103(a) to be of such insubstantial credible weight as to warrant expanding the volume of the rejection by including a novelty rejection under 35 U.S.C. § 102(b) as well. Applicants respectfully request clarification on this point so that the record of prosecution may be rendered clear on potential Appeal.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP 2143. Additionally, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not in Applicants’ disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

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skill in the art, to modify Moy or to combine Moy with any other reference to practice the invention of Applicants' claims **1** and **22**.

It is important to note that the Examiner has failed to disclose a combination of Moy with any reference or teaching of record. Accordingly, there can be no motivation or suggestion to combine when a combination is not even proposed. Applicant's respectfully request clarification on this point so that Applicants are not forced to perform guesswork to determine how the Examiner has formulated the rejection under 35 U.S.C. § 103(a).

Additionally, because there is no motivation or suggestion to combine Moy with any other reference to practice the invention of claims **1** and **22**, there can be no reasonable expectation of success. Accordingly, claims **1** and **22** may not properly be regarded as obvious under § 103(a). See, for example, *Akamai Technologies, Inc. v. Cable & Wireless Internet Services, Inc.*, 344 F.3d 1186 (Fed. Cir. 2003) (There must be some teaching, suggestion, or motivation to combine references.); *Teleflex, Inc. v. Ficosa North American Corp.*, 299 F.3d 1313 (Fed. Cir. 2002) (The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence.) (citing *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999)); *Carella v. Starlight Archery*, 804 F.2d 135 (Fed. Cir. 1986) (Obviousness cannot be established by combining teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting a combination.); *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984) (The fact that the prior art could be modified so as to produce the claimed invention is not a basis for an obviousness rejection, unless the prior art suggested the desirability of the modification.); and *Ex parte Walker*, 135 USPQ 195 (POBA 1961) (A combination of teachings must be proposed and the art should contain some suggestion of the desirability of making the proposed combination.)

"With respect to core factual findings in a determination of patentability, [the Examiner] cannot simply reach conclusions based on [his/her] own understanding or experience – or on [his/her] assessment of what would be basic knowledge or common sense. Rather [the Examiner] must point to some concrete evidence in the record in support of these findings." *In Re Zurko*, 258 F.3d 1379 (2001).

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therefore submit that claims **1-33** and **22-34** are allowable in view of Moy reference and respectfully request Examiner to withdraw the § 103(a) rejections of the same.

## **CONCLUSION**

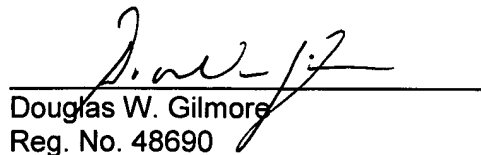
The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended. Claims **1-13** and **22-34** are pending in the application. Reconsideration of the previously pending claims **1-13** and **22-34** and allowance of all claims **1-13** and **22-34**, as amended is earnestly requested.

No amendment made herein was related to the statutory requirements of patentability unless expressly stated; rather any amendment not so identified may be considered as directed *inter alia* to clarification of the structure and/or function of the invention and Applicant's best mode for practicing the same. Additionally, no amendment made herein was presented for the purpose of narrowing the scope of any claim, unless Applicant has argued that such amendment was made to distinguish over a particular reference or combination of references. Furthermore, no election to pursue a particular line of argument was made herein at the expense of precluding or otherwise impeding Applicant from raising alternative lines of argument later during prosecution. Applicant's failure to affirmatively assert specific arguments is not intended to be construed as an admission to any particular point raised by the Examiner.

Should the Examiner have any questions regarding this Response and Amendment or feel that a telephone call to the undersigned would be helpful to advance prosecution of this matter, the Examiner is invited to call the undersigned at the number given below.

Respectfully submitted,  
ATTORNEY FOR APPLICANT

Date: 12/08/2005

  
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Douglas W. Gilmore  
Reg. No. 48690

NOBLITT & GILMORE, LLC  
4800 North Scottsdale Road, Suite 6000  
Scottsdale, Arizona 85251

(480) 994-9869 Tel.  
(480) 994-9025 Fax

DWG:aes